

Docket No. 24180-124005

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re U.S. Patent Application of:

Applicant: RICHARDS *et al.*

Appln. No. ¹⁰/046,500

Filed: October 24, 2001

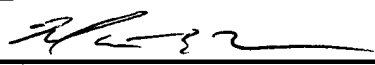
For: POLYPROPYLENE CONTAINER AND
PROCESS FOR MAKING THE SAME

) Examiner: Sandra M. Nolan

) Group Art Unit: 1772

) Certificate of Mailing

) I, hereby certify that this correspondence (along with any
) documents referred to as attached or enclosed) is being deposited
) with the US Postal Service as first class mail in an envelope
) addressed to: Mail Stop Amendment, Commissioner for Patents,
) P.O. Box 1450, Alexandria, VA 22313-1450, on August 11,
) 2004.

) 
) _____
) Matthew E. Leno, Reg. No. 41,149

RESPONSE UNDER 37 C.F.R. §1.116

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

This paper is submitted in response to the Office Action mailed May 13, 2004. Reconsideration of the above-identified application in light of this paper is respectfully requested.

STATUS OF PROSECUTION

The May 13, 2004 Office Action has withdrawn the outstanding rejections under 35 U.S.C. §112, but maintains the outstanding rejections of claims 25-28 and 30-41 as anticipated under 35 U.S.C. §102 by U.S. Patent No. 5,804,016 to Schmidt ("Schmidt") and claim 29 as obvious over Schmidt in view of U.S. Patent No. 5, 303,834 to Krishnakumar ("Krishnakumar"); both as originally set forth in the August 13, 2003 Office Action in the above-identified application.

In response to the August 13, 2003 Office Action, Applicants filed a November 13, 2003 AMENDMENT UNDER 37 C.F.R. §1.111 and subsequently filed a February 27, 2004 Response to a February 9, 2004 Office Action that asserted the November 13, 2003 amendment was not fully responsive to the August 13, 2003 Office Action. The presently outstanding May 13, 2004 Office

Action was the first substantive response from the Office to Applicants' November 13, 2003 Amendment.

The August 13, 2003, Office Action rejected claims 25-28 and 30-41 under 35 U.S.C. §102(b) as anticipated by Schmidt and claim 29 under 35 U.S.C. §103(a) as unpatentable over Schmidt in view of Krishnakumar. Applicants' November 13, 2003 AMENDMENT UNDER 37 C.F.R. §1.111 clearly demonstrated that Schmidt's disclosure of a perform configuration for a preform constructed of PET, was not combinable with Schmidt's vague disclosure of using polypropylene to construct a perform without reference to its geometric construction. The rejection of claim 29 in the August 13, 2003 Office Action was based, in part, on this improper combination of these disclosures by Schmidt. Thus, by disproving the relied upon teachings of Schmidt, Applicants disproved the rejections of all claims 25-41.

Applicants' November 13, 2003 AMENDMENT UNDER 37 C.F.R. §1.111 relied, in part, on a 37 C.F.R. §1.132 DECLARATION OF DR. ROBERT KNOLL. The presently outstanding May 13, 2004 Office Action did not consider that declaration. Applicants respectfully assert that the declaration was submitted as part of the November 13, 2003 AMENDMENT UNDER 37 C.F.R. §1.111 and should have been considered with the arguments submitted therewith.

For the reasons set forth below, Applicants traverse the outstanding rejections and submit, in support thereof, the attached SECOND 37 C.F.R. §1.132 DECLARATION OF DR. ROBERT KNOLL. Applicants also submit herewith a NOTICE OF APPEAL.

RESPONSE

Applicants submit herewith a Second 37 C.F.R. §1.132 Declaration of Dr. Robert Knoll for consideration in support of the arguments presented in Applicants' November 13, 2003, AMENDMENT UNDER 37 C.F.R. §1.111 and reassert those same arguments here by reference supported by the SECOND 37 C.F.R. §1.132 DECLARATION OF DR. ROBERT KNOLL.

The May 13, 2004 Office Action states that:

"Most importantly, Schmidt states that "one or more layers of the perform and container...can be made of various other polymers, such as polyolefins (e.g., polypropylene and polyethylene)... (*emphasis added to Schmidt by Office Action*)

(Office Action, p. 6) This statement crystallized the fact that the outstanding rejection relies exclusively on the disclosure of polypropylene and not on any teaching of how that polypropylene is to be used to construct a the preform according to the teachings of Schmidt -- because there is none. Applicants respectfully assert that the Office Action fails to appreciate the significance of changing the material properties of the preform. The SECOND 37 C.F.R. §1.132 DECLARATION OF DR. ROBERT KNOLL attempts to explain the significance of switching from PET to polypropylene and the changes necessitated by that switch. Schmidt could disclose aluminum as an alternative material from which to comprise the preform, but without teaching how to change the preform to accommodate that change, the preform could not be manufactured and that hypothetical teaching would be insufficient for anticipation. Although the difference between PET and polypropylene is not as dramatic as the difference between PET and aluminum, the SECOND 37 C.F.R. §1.132 DECLARATION OF DR. ROBERT KNOLL verifies that differences are significant and same principal applies.

To anticipate, Schmidt must enable claims 25-41 so as to place the invention there claimed in the possession of the public. *See, e.g., Akzo N.V. v. United States ITC*, 808 F.2d 1471, 1 U.S.P.Q.2d 1241 (Fed. Cir. 1986); *Ashland Oil, Inc. v. Delta Resins & Refracs., Inc.*, 776 F.2d 281, 227 U.S.P.Q. 657 (Fed. Cir. 1985). Since Schmidt fails to teach how to accommodate the differences in material properties of PET and polypropylene, Schmidt cannot anticipate claims 25-41 of the instant application. (*See*, SECOND 37 C.F.R. §1.132 DECLARATION OF DR. ROBERT KNOLL)

Applicants also submit for consideration the recent opinion of the Board of Patent Appeals and Interferences in *Ex Parte Beuther* which is directly applicable to the outstanding rejection. 71 U.S.P.Q.2d 1313 (BPAI 2003). In *Beuther*, the Board reconfirmed old law stating that:

[i]t is well settled...that anticipation is **not established** if in reading a claim on something disclosed in a reference **it is necessary to pick, choose and combine various portions of the disclosure not directly related** to each other by the teachings of the reference. (*emphasis added*)

71 U.S.P.Q.2d at 1316 (*citing In re Arkley*, 455 F.2d 586, 587-88, 172 U.S.P.Q. 524, 526 (CCPA 1972)). The Board there relied on the CCPA's statement in *Arkley* that:

Such picking and choosing...has no place in the making of a 102, anticipation rejection.

455 F.2d at 587-88, 172 U.S.P.Q. at 526. While *Beuther* is not binding precedent on the Board, it reliance on *Arkley* by the CCPA which stand for the same proposition signifies that this proposition is binding on the Office.

That law is directly applicable to the outstanding rejection in which the assortment of substitute materials from which Office Action chooses polypropylene is not directly related to the preform disclosed by Schmidt. The specific characteristics of the preform disclosed by Schmidt are a direct result of the PET for which Schmidt designed the disclosed injection process. The combination of the polypropylene mentioned by Schmidt with the preform design that is specifically designed for use with PET clearly constitutes a picking and choosing from "various portions of the disclosure not directed related to each other...." *Beuther*, 71 U.S.P.Q.2d at 1316 (citing *Arkley*, 455 F.2d at 587-88, 172 U.S.P.Q. at 526). Accordingly, the outstanding rejection is improper under *Arkley* as explained in *Beuther*.

CONCLUSION

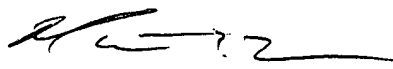
Applicants assert that this application is in condition for allowance. Early action to that end is requested.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP

Date: August 11, 2004

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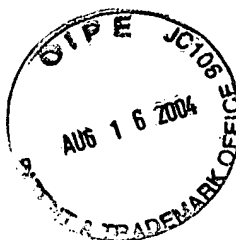
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Registration No. 41,149
Attorney for Applicant

CERTIFICATE OF MAILING

I hereby certify that this correspondence with attachments are being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

AF/1772
IFW

on August 11, 2004
Date of Mailing
Matthew E. Leno
Applicant, Assignee or Registered Representative
[Signature]
Signature
August 11, 2004
Date of Signature



RESPONSE TO OFFICE ACTION TRANSMITTAL LETTER			ATTORNEY'S DOCKET NO. 24180-124005
APPLN. NO. 10/046,500	FILING DATE October 24, 2001	EXAMINER S. Nolan	GROUP ART UNIT 1772
INVENTOR(S) Richards, et al.			
TITLE OF INVENTION Polypropylene Container and Process for Making the Same with Barrier Protection			

TO THE COMMISSIONER FOR PATENTS

Transmitted herewith is the Response to Office Action dated May 13, 2004, and Declaration of Dr. Robert Knoll.

- ☐ Small entity status of this application under 37 CFR 1.27 has been established by a verified statement previously submitted.
- ☐ A verified statement to establish a small entry status under 37 CFR 1.9 and 1.27 is enclosed.
- ☐ A request for a ___-month extension of time is enclosed.
- ☒ No additional claim fee is required.
- ☐ The fee has been calculated as shown below:

	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NO. PREVIOUSLY PAID FOR	PRESENT EXTRA
TOTAL		MINUS	20	
INDEP.		MINUS	3	
FIRST PRESENTATION OF MULTIPLE DEP. CLAIM				

SMALL ENTITY		OR	OTHER THAN A SMALL ENTITY	
RATE	ADD'L FEE		RATE	ADD'L FEE
x \$9 =	\$0		x \$18 =	\$
x \$43 =	\$0		x \$86 =	\$
x \$145 =	\$		x \$290 =	\$
TOTAL ADD'L FEE	\$	OR	TOTAL ADD'L FEE	\$

- ☐ Please charge Deposit Account No. 13-0206 in the amount of \$0.00 for the Response to Office Action. A duplicate copy of this sheet is enclosed.
- ☐ A check in the amount of \$_____ to cover filing fee is enclosed.
- ☒ The Commissioner is hereby authorized to charge payment of any additional filing fees required under 37 CFR 1.16 and any patent application processing fees under 37 CFR 1.17 associated with this communication or credit any overpayment to Deposit Account No. 13-0206. A duplicate copy of this sheet is enclosed.
- ☐ I hereby petition under 37 CFR 1.136(a) for any extension of time required to ensure that this paper is timely filed. Please charge any associated fees which have not otherwise been paid to Deposit Account No. 13-0206. A duplicate copy of this sheet is enclosed.

August 11, 2004
(Date)

SIGNATURE: [Signature]
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